



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,915	09/18/2003	Rajendra Mehta	STD 1184 PA/41213.541	6466
23368 7590 03/20/2007 DINSMORE & SHOHL LLP ONE DAYTON CENTRE, ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402-2023			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/20/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/666,915

Applicant(s)

MEHTA ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 50-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 60-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed December 20, 2006.

Claims 1-63 are pending, with claims 50-59 withdrawn as a non-elected invention.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-7, 9-12, 18-22, 30-32 and 60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Lakes et al. (U.S. 5,912,205).

Lakes discloses a security document to provide an authentication feature and/or an indicated of attempted alterations from the sue of solvents, heat or abrasion, where the security document comprises a substrate having a composition on one of its major surfaces which activates to produce a color upon the application of a solvent, heat or abrasion (column 2, lines 5-15) where the color forming composition may be fully coated on the entire surface of the substrate or spot coated onto one ore more predetermined areas of the substrate and may be printed as covert authentication indicia (column 4, lines 49-55). The covert warning indicia printed on the document can have a pattern

Art Unit: 1774

such as VOID on the surface of the substrate (column 2, lines 39-44 and Figures 2-3). Lakes further discloses one embodiment of the invention is to have authentication indicia on one portion of the document and a covert warning indicia on another portion of the document (column 5, lines 1-6) where the document shows attempted alteration by the use of solvents (column 5, lines 25-29). A toner adhesion composition is applied over the color forming composition, which can be removed through abrasion such as vigorous rubbing (column 5 lines 49-67). Lakes discloses using laser printing and using the security documents for checks and documents of value (column 3, lines 62-67) where the document is printed using flexographic printing (column 5, lines 20-22 and column 7, lines 15-17, 41-44).

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205).

Lakes is relied upon for instant claim 1. Lakes does not explicitly disclose the percentages of the flexographic ink components. Lakes does not show that the flexographic ink has a property percentage as in instant claim 8. However, such

Art Unit: 1774

percentages are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the property percentages, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. percentage) fails to render claims patentable in the absence of unexpected results. The flexographic printing composition percentages are optimizable as they directly affect the opacity of the document. It would have been obvious to one of ordinary skill in the art to make the security document with the limitations of the flexographic ink percentage properties since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Claim Rejections – 35 USC § 103(a)

6. Claims 15-17 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Taylor et al (U.S. 6,062,604).

Lakes is relied upon for claim 1. Lakes does not disclose folding the document. Taylor teaches a security document comprising optically variable ink (column 1, lines 9-21) formed from a substrate having a coating on one or both sides, where the sheet is flexible and can be folded about a center line, which bring both sides of the folded article together (column 2, lines 22-46). Lakes and Taylor are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have folded the security document, as taught in Taylor, in the security document of Lakes so the

Art Unit: 1774

second portion of the security document can be inspected or verified by viewing both the first and second portions together (column 2, lines 54-64).

Claim Rejections – 35 USC § 103(a)

7. Claims 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Berson (U.S. 5,932,870).

Lakes is relied upon for claim 1. Lakes does not disclose a bar code. Berson teaches a security document in the form of a driver's license having a bar code for abrasion resistance. Lakes and Berson are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have included a bar code, as taught in Berson, in the security document of Lakes to improve the security for the documents (column 2, lines 20-27).

Claim Rejections – 35 USC § 103(a)

8. Claim 13-15 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Halbrook, Jr. et al. (U.S. 5,883,043).

Lakes is relied upon for claim 1, as above. Lakes does not explicitly disclose optically variable ink such as thermochromic ink. Halbrook, Jr. teaches a security document (column 1, lines 5-10) having optically variable pigments and dyes such as thermochromic (column 3, lines 1-5). Lakes are Halbrook, Jr. are both directed to security documents. It would have been obvious to one of ordinary skill in the art to

Art Unit: 1774

have included thermochromic ink, as taught in Halbrook, Jr., in the security document of Lakes to improve the security for the document.

Claim Rejections – 35 USC § 103(a)

9. Claims 4-5, 24-29, 33-46 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Lu (U.S. 5,591,527).

Lakes is relied upon for claim 1, as above. Lakes does not disclose the article is a drivers license. Lu teaches security articles comprising an image or design (column 1, lines 50-55) having a separation layers (column 2, lines 10-25) where the substrate may be made of paper and is a drivers license (column 3, lines 1-5). Lu further teaches the article has a layer to protect the substrate (column 5, lines 17-22) having a laminate comprising two or more layers (column 12, lines 55-60) which are tear resistant. The article can be coated on the back side of the article (column 16, lines 5-11). Lakes and Lu are both directed to security documents. It would have been obvious to one of ordinary skill in the art for the security document to be drivers license, as taught in Lu having the added security features to protect and identify the consumers using the security cards.

Response to Arguments

10. Applicant's arguments to rejection made under 35 U.S.C. 102(b) as being anticipated by Lakes et al. (U.S. 5,912,205) has been considered but is unpersuasive.

Art Unit: 1774

Applicant argues at most Lakes teaches two coating compositions with messages that are interspersed with one another and adjacent to one another, but not on one another. Examiner is not persuaded by this argument because Lakes discloses a security document to provide an authentication feature and/or an indication of attempted alterations from the use of solvents, heat or abrasion, where the security document comprises a substrate having a composition on one of its major surfaces which activates to produce a color upon the application of a solvent, heat or abrasion (column 2, lines 5-15) where the color forming composition may be fully coated on the entire surface of the substrate or spot coated onto one or more predetermined areas of the substrate and may be printed as covert authentication indicia (column 4, lines 49-55). Lakes further discloses a toner adhesion composition is applied over the color forming composition, which can be removed through abrasion such as vigorous rubbing (column 5 lines 49-67). Applicants further argue even though the toner-adhesion enhancing coating is depicted as being a separate layer that is on top of the tamper-evident coating, there is no indication that it provides evidence of tampering. Applicant argues its purpose is to provide improved adhesion of toner particles to the security document when printed with a laser or other noncontact printer. Figure 1 shows a substrate (12) with a color forming composition layer (14) and a toner adhesion enhancing coating (16) comprising insulating material (15). In column 5, lines 56-59, Lakes discloses the insulating material, which is comprised within the toner adhesion enhancing coating, is removed by vigorously rubbing the material. If the insulating material of the toner adhesion enhancing coating is removed by vigorous rubbing, this provides a separate

Art Unit: 1774

indicia of tampering from the color forming composition layer (coating that is sensitive to a solvent).

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lakes has been considered but is unpersuasive. Applicant argues Lakes is inappropriate as an obviousness rejection based upon the same arguments made regarding the 102(b) rejection. Because the 102(b) rejection under Lakes has been maintained and Applicant has not made any additional arguments regarding the 103(a) rejection, the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lakes is maintained for reasons of record.

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lakes in view of Taylor et al (U.S. 6,062,604) has been considered but is unpersuasive. Applicant argues the secondary reference does not correct the deficiency of Lakes. Because Lakes has been maintained, Lakes in view of Taylor is also maintained for reasons of record.

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lakes in view of Berson (U.S. 5,932,870) has been considered but is unpersuasive. Applicant argues the secondary reference does not correct the deficiency of Lakes. Because Lakes has been maintained, Lakes in view of Berson is also maintained for reasons of record.

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lakes in view of Halbrook, Jr. et al (U.S. 5,883,043) has been considered but is unpersuasive. Applicant argues the secondary reference does not

Art Unit: 1774

correct the deficiency of Lakes. Because Lakes has been maintained, Lakes in view of Halbrook, Jr. is also maintained for reasons of record.

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lakes in view of Lu (U.S. 5,591,527) has been considered but is unpersuasive. Applicant argues the secondary reference does not correct the deficiency of Lakes. Because Lakes has been maintained, Lakes in view of Lu is also maintained for reasons of record.

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1774


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L. Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1774